

U.S. Application No. 09/757,471

Docket No. 3562-0112P

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REMARKS

Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks. Claims 1-34 were pending prior to the Office Action. Claims 4, 18, and 21 have been canceled and claims 35-43 have been added through this Reply. Therefore, claims 1-3, 5-17, 19-20, and 22-43 are pending. Claims 1, 17, 34, 35, 38, and 41 are independent.

OBJECTION TO THE TITLE

The title is objected to for minor informalities. See *Office Action*, page 2, item 1. The title has been amended to address this objection. Applicants respectfully request that the objection to the title be withdrawn.

§ 102 REJECTION - YAMAUCHI

Claims 1-6, 9-13, 15, 17-23, 26, 30, 32, and 34 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Yamauchi et al. (USPN 6,020,982, hereinafter "Yamauchi"). Dependent claims 4, 18, and 21 have been canceled and the features thereof have been incorporated into the respective

independent claims. Therefore, after amendments are entered, claims 1-3, 5-6, 9-13, 15, 17, 19-20, 22-23, 26, 30, 32, and 34 stand rejected. Applicants respectfully traverse.

For a Section 102 rejection to be proper, the cited reference must teach or suggest each and every claimed element. See *M.P.E.P.* 2131; *M.P.E.P.* 706.02. Thus, if the cited reference fails to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

In this instance, Yamauchi fails to teach or suggest each and every claimed element. For example, independent claim 1 recites, in part, "wherein said predetermined automatic selection basis is set based on the order of media loaded to said plurality of medium wearable units." Independent claims 17 and 34 also recite similar features. Yamauchi cannot be relied upon to teach or suggest at least this feature.

Yamauchi is directed towards image data processing apparatus for converting an optical image taken by a camera into a digital image data, and recording and reproducing on a recording medium. See *Yamauchi*, column 1, lines 13-18. In the Office Action, the Examiner asserts that Figure 76 and column 44,

line 58 - column 45, line 14 teaches this feature. See *Office Action, page 4, second and third paragraphs.*

However, closer inspection of Yamauchi reveals the following. Yamauchi teaches that the card selection control part 629a selects either the card type connector 504 or the memory card 400 inserted in the card selection parts 614 and 615 and the card tray 616 of the editing machine 600. See *Figures 62 and 76*. Yamauchi merely discloses that the memory card 400 or the card type connector 504 may be selected. It is noted that there is no discussion regarding significance of loading order of the media.

The Examiner asserts, "when that card is full, the device will then transfer the data to the other memory card by suing the other selection bus." See *Office Action, page 4, third paragraph.*

Contrary to the Examiner's assertion, there is no such discussion. Yamauchi discloses that the setting of the transfer start address, setting of the number of bytes to be transferred, and confirmation of the end of data transfer are performed. See *Yamauchi, column 45, lines 4-7*. Yamauchi also discloses that checking of protect state (write disabled state, etc.),

confirmation of backup battery of the memory card, and selection of the bus to be connected are performed. See *Yamauchi*, column 45, lines 9-11. However, *Yamauchi* is silent with regard to the feature of the predetermined automatic selection basis is set based on the order of media loaded to said plurality of medium wearable units as required.

Therefore, for at least these reasons, independent claims 1, 17, and 34 are distinguishable from *Yamauchi*. Claims 1-3, 5-6, 9-13, 15, 19-20, 22-23, 26, 30, and 32 depend from claims 1 or 17 directly or independently. Therefore, for at least the reasons stated with respect to claims 1 and 17, these dependent claims are also distinguishable from *Yamauchi*.

Applicants respectfully request that the rejection of claims 1-3, 5-6, 9-13, 15, 17, 19-20, 22-23, 26, 30, 32, and 34 based on *Yamauchi* be withdrawn.

§ 103 REJECTION - YAMAUCHI, AKAMINE

Claims 7-8 and 24-25 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Yamauchi* in view of *Akamine et al.* (USPN Re. 36,589, hereinafter "*Akamine*"). Applicants respectfully traverse.

For a Section 103 rejection to be proper, a *prima facie* case of obviousness must be established. See *M.P.E.P.* 2142. One requirement to establish *prima facie* case of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. See *M.P.E.P.* 2142; *M.P.E.P.* 706.02(j). Thus, if the cited references fail to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

In this instance, independent claim 1 recites, in part, "wherein said predetermined automatic selection basis is set based on the order of media loaded to said plurality of medium wearable units." Independent claims 17 also recite a similar feature.

It has been shown above that claims 1 and 17 are distinguishable over Yamauchi. Akamine has not been, and indeed cannot be, relied upon to correct for at least the above-noted deficiencies of Yamauchi. Therefore, independent claims 1 and 17 are distinguishable over the combination of Yamauchi and Akamine.

Claims 7-8 and 24-25 depend from claims 1 or 17 directly or independently. Therefore, for at least the reasons stated with

respect to claims 1 and 17, these dependent claims are also distinguishable from the combination of Yamauchi and Akamine.

Applicants respectfully request that the rejection of claims 7-8 and 24-25 based on Yamauchi and Akamine be withdrawn.

§ 103 REJECTION - YAMAUCHI, MURATA

Claims 14 and 31 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Yamauchi in view of Murata et al. (USPN 5,627,587, hereinafter "Murata"). Applicants respectfully traverse.

It has been shown above that claims 1 and 17 are distinguishable over Yamauchi. Murata has not been, and indeed cannot be, relied upon to correct for at least the above-noted deficiencies of Yamauchi. Therefore, independent claims 1 and 17 are distinguishable over the combination of Yamauchi and Murata.

Claims 14 and 31 depend from claims 1 or 17 directly or independently. Therefore, for at least the reasons stated with respect to claims 1 and 17, these dependent claims are also distinguishable from the combination of Yamauchi and Murata.

Applicants respectfully request that the rejection of claims 14 and 31 based on Yamauchi and Murata be withdrawn.

§ 103 REJECTION - YAMAUCHI, WAKUI

Claims 16 and 33 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Yamauchi in view of Wakui (USPN 5,986,700). Applicants respectfully traverse.

It has been shown above that claims 1 and 17 are distinguishable over Yamauchi. Wakui has not been, and indeed cannot be, relied upon to correct for at least the above-noted deficiencies of Yamauchi. Therefore, independent claims 1 and 17 are distinguishable over the combination of Yamauchi and Wakui.

Claims 16 and 33 depend from claims 1 or 17 directly or independently. Therefore, for at least the reasons stated with respect to claims 1 and 17, these dependent claims are also distinguishable from the combination of Yamauchi and Wakui.

Applicants respectfully request that the rejection of claims 16 and 33 based on Yamauchi and Wakui be withdrawn.

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NEW CLAIMS

Claims 35-43 have been added through this reply. All new claims are believed to be distinguishable over the cited references, individually or in any combination. Applicants respectfully request that the new claims be allowed.

CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

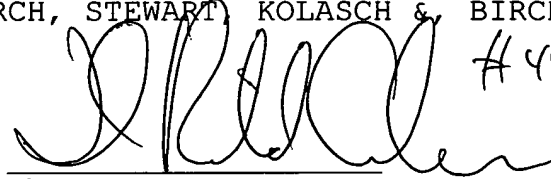
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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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